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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,640	05/23/2001	Akira Tsubokura	38331-0002	3145

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EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 12/12/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/856,640**

Applicant(s)  
**Tsubokura et al.**

Examiner  
**Sandra Saucier**

Art Unit  
**1651**



-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 6, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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#### DETAILED ACTION

Claims 1-10 are pending. Claims 1-6 are considered on the merits. Claims 7-10 are withdrawn from consideration as being drawn to a non-elected invention.

#### *Election/Restriction*

Applicant's election without traverse of Group I in Paper No. 7 is acknowledged.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections – 35 USC § 102*

Claims 1-6 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,607,839 [A].

The claims are directed to a culture "precipitate" which comprises at least 3 mass % of carotenoids.

The references are relied upon as explained below.

US 5,607,839 discloses the same microbe as the instant one, namely FERM BP-4283, which is cultured and then centrifuged to obtain the cells. See Example 3, line 22, Example 4, line 6, Example 5, line 46 etc..

While applicant is using the term, "precipitate" incorrectly, see Grant and Hackh's Chemical Dictionary appended, to mean that the cells which have been cultured have been removed from the medium by filtration or centrifugation (specification page 4, last paragraph), the claim is examined in the light of the specification to include centrifugation and filtration as "precipitation" means.

Please note that to truly precipitate a substance from solution requires that the substance initially be soluble in the solution and then rendered insoluble by heat, chemical reaction, etc.. Cells cannot be precipitated from a solution because they are not soluble in the solution, but merely are suspended in the culture medium.

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*Response to Arguments*

Applicant's arguments filed 2/27/02 have been fully considered but they are not persuasive.

Applicants argue that US '839 does not disclose removing the moisture from a culture precipitate, but teaches the use of solvent extraction.

While it is true that the methods in '839 further treat the cell biomass after removal of the water by centrifugation with a solvent, the instant claims are not method claims, but composition claims. The composition, a cell "precipitate" which can be centrifuged cells where the liquid medium has been removed from the cell mass is clearly described. That it is only an intermediate in the prior art is of no patentable consequence.

Applicants further argue that '839 does not mention "at least 98% homology". However, the composition disclosed in '839 must have at least 98% homology, more likely 100% homology in the 16S rRNA sequence, because the cells ARE THE SAME (FERM BP-4283). The SAME CELLS would have the SAME SEQUENCE. This is an inherent property of the cell.

*Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal

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work schedule for Examiner Saucier is 8:30AM to 5:00PM Monday, Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.

A handwritten signature in black ink, appearing to read 'Sandra Saucier', with a stylized, cursive script.

Sandra Saucier  
Primary Examiner  
Art Unit 1651  
December 11, 2002

## pralidoxime chloride

m.220, soluble in water. An antidote to organophosphorus insecticides (USP).

**Prandtl number** *Pr*. Specific heat capacity at constant pressure  $\times$  kinematic viscosity/thermal conductivity. Cf. *Reynolds number*.

**prase** (1) Greenish. (2) A gray-green chalcidony.

**praseodymia** The earth corresponding with the element praseodymium.

**praseodymium**\* *Pr* = 140.9077. A rare-earth metal, at. no. 59. Green metal, d.6.48, m.930, slowly decomp. in water. Separated (1885) by Auer von Welsbach from the earth didymia, and occurs in cerite and rare-earth minerals. Principal valency 3. See *didymium*. *p. acetate*\*  $\text{Pr}(\text{C}_2\text{H}_3\text{O}_2)_3 \cdot 3\text{H}_2\text{O}$  = 372.1. Green needles, soluble in water. *p. chloride*\*  $\text{PrCl}_3$  = 247.3. Green needles, m.818; soluble in water. *p. oxalate*\*  $\text{Pr}_2(\text{C}_2\text{O}_4)_3 \cdot 10\text{H}_2\text{O}$  = 736.1. Green crystals, insoluble in water. *p. oxides* (1)  $\text{Pr}_2\text{O}_3$  = 329.8. P. trioxide\*. Yellow-green powder. (2)  $\text{Pr}_2\text{O}_4$  = 345.8. P. pentaoxide\*. Black powder. (3)  $\text{Pr}_2\text{O}_5$  = 361.8. P. pentaoxide\*. *p. phosphate*\*  $\text{PrPO}_4$  = 235.9. Green powder for coloring ceramics. *p. sulfate*\*  $\text{Pr}_2(\text{SO}_4)_3 \cdot 8\text{H}_2\text{O}$  = 714.1. Green crystals, soluble in water. *p. sulfide*\*  $\text{Pr}_2\text{S}_3$  = 378.0. Brown powder, decomp. by heat, insoluble in water.

**praseolite** A green alteration product of iolite.

**prazosin hydrochloride**  $\text{C}_{19}\text{H}_{21}\text{O}_4\text{N}_5 \cdot \text{HCl}$  = 419.9.

**precipitate** Abbrev. ppt (no period). (1) To cause a substance to be precipitated. (2) The deposit of an insoluble substance in a solution as a result of a chemical reaction after the addition of a precipitating reagent. Cf. *schwellenwert*. *banded* ~ Periodic *p.* *black* ~ Mercurous oxide. *group* ~ The *p.* formed by a group precipitant consisting of substances of related properties. See *qualitative analysis* under *analysis*. *periodic* ~ See *Liesegang rings*. *red* ~ Red mercuric oxide. *white* ~ Ammoniated mercury. *yellow* ~ Yellow mercuric oxide.

**precipitinogen** A substance which, on injection, causes the formation of precipitins.

**precipitum** The deposit formed by the action of precipitins.

**precision** The degree of mutual agreement between individual measurements, such as the *standard deviation*, q.v., as distinct from their accuracy. *p. instrument* An instrument capable of precise measurements.

**precursor** (1) A substance synthesized in the dark by an organism, and decomposed by light. Cf. *photoproduct*. (2) A substance that forms the raw material for the synthesis of protoplasm in the living animal body. (3) A substance that precedes the formation of another compound. Cf. *provitamin*.

**predissociation** A spectral phenomenon by which a molecule dissociates at a lower level than its dissociation energy.

**prednisolone**  $\text{C}_{21}\text{H}_{28}\text{O}_5$  = 360.5. Sterane. Delta Cortef. White, bitter crystals, m.229 (decomp.), soluble in water; a cortisone substitute, as it has fewer side effects (USP, EP, BP).

*p. sodium phosphate*  $\text{C}_{21}\text{H}_{27}\text{O}_6\text{Na}_2\text{P}$  = 484.4. Bitter, white powder, soluble in water; a synthetic glucocorticoid. Used for its anti-inflammatory effect in blood diseases and allergic states (USP, BP).

**prednisone**  $\text{C}_{21}\text{H}_{26}\text{O}_5$  = 358.4. White, bitter crystals, insoluble in water; used similarly to prednisolone (USP, EP, BP).

**preform** Material produced in a state ready for molding to a desired shape, e.g., plastic-impregnated wood pulp for molded panels.

**Pregl, Fritz (1868-1930)** Austrian chemist, noted for his development of quantitative microanalysis. Nobel prize winner (1923).

**pregnancy test** Detection of chorionic gonadotrophin in urine by antibody-antigen reaction, or by radioimmunoassay of blood serum.

**pregnane**  $\text{C}_{21}\text{H}_{36}$  = 288.5. A tetracyclic hydrocarbon, androstane derivative. Parent compound of some natural steroids, including mammalian hormones. *p. diol*  $\text{C}_{21}\text{H}_{36}\text{O}_2$  = 320.5. A sterol, m.233, from the urine of pregnant women.

*p. dione*  $\text{C}_{21}\text{H}_{32}\text{O}_2$  = 316.5. A ketone derivative of *p. diol*.

**pregnanolone**  $\text{C}_{21}\text{H}_{34}\text{O}_2$  = 318.5. A metabolite of progesterone.

**pregnene**  $\text{C}_{21}\text{H}_{34}$  = 286.2.  $\Delta^{5,6}$ -pregnane. An androstane derivative.

**pregneninolone** Ethisterone.

**pregnattite** A variety of muscovite from Tyrol.

**prehnite**  $\text{H}_2\text{Ca}_2\text{Al}_2(\text{SiO}_4)_3$ . A hydrous silicate.

**prehnitene**  $\text{C}_{10}\text{H}_{14}$  = 134.2. Prenitol, 1,2,3,4-Tetramethylbenzene\*. Colorless liquid, b.204, insoluble in water.

**prehnitic acid**  $\text{C}_{10}\text{H}_8\text{O}_8$  = 254.2. 1,2,3,5-Benzenetetra-carboxylic acid\*. Colorless crystals, m.252. Cf. *mellophanic acid*.

**prehnitic acid** 2,3,4-Trimethylbenzoic acid\*.

**preignition** See *knock*.

**preimpregnate** (1) To impregnate prior to a subsequent stage in a process. (2) A substance used to hold the ingredients of mix together, before resin impregnation and molding; e.g., polyester resins.

**Prelog, Vladimir (1906- )** Bosnian-born Swiss chemist. Nobel prize winner (1975), noted for work on the chirality of organic compounds.

**premier alloy** A heat-resisting alloy: Ni 61, Fe 25, Cr 11.3%.

**prenyl** The 3-methyl-2-butenyl\* radical,  $\text{Me}_2\text{C}:\text{CH} \cdot \text{CH}_2$ .

**prep** Abbreviation for "preparation."

**preparation** (1) A chemical process for the production of